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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION OF: William T. Ball
SERIAL NO.: 10/732,726
TITLE: METHOD AND APPARATUS FOR ASSEMBLING AND
SEALING BATHTUB OVERFLOW AND WASTE WATER
PORTS
FILED: December 10, 2003
GROUP/A.U.: 3751
Confirmation No.: 2017
EXAMINER: Robert M. Fetsuga
Atty. Docket No.: P06239US1-152

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

This is an appeal from the final rejection of claims 1, 5, 6 and 10 dated October 24, 2005.

I. Real Party In Interest:

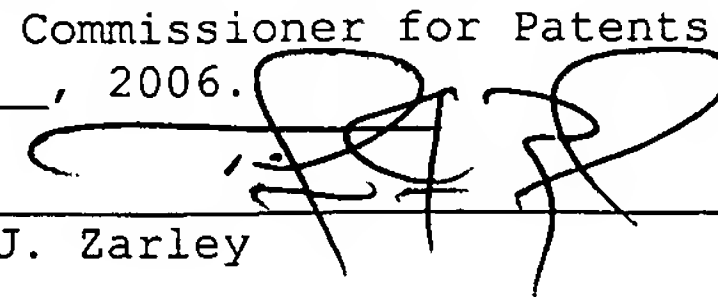
The real party in interest of the instant appeal is WCM Industries, Inc., a Colorado corporation, having offices at 2121 Waynoka Road, Colorado Springs, CO 80915.

II. Related Appeals and Interferences:

There are no related appeals or interferences.

CERTIFICATE OF MAILING (37 C.F.R. § 1.8(A))

I hereby certify that this document and the documents referred to as enclose therein are being deposited with the United States Postal Service as First Class mail addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, Alexandria, VA 22313-1450, on this 23rd day of March, 2006.



Timothy J. Zarley

III. Status of the Claims:

Presently, claims 1, 5-8 and 10 are pending in this application and appear in Appendix A of this brief. Claims 7 and 8 have been withdrawn. Claims 1, 5, 6 and 10 are rejected and are the subject matter of this appeal.

IV. Status of Amendments:

Subsequent to the Examiner's final rejection dated October 24, 2005, no amendments to the claims have been made.

V. Summary of Claimed Subject Matter:

Claim 1 is for a method of conducting a fluid leakage test on a fluid system comprising a bathtub 20 which is a bottom 26 adjacent side 22 and end walls 24, and an overflow port 30 and an end wall 24 with the bottom 26 having a waste water port being in communication with a primary drain system 34A. (Page 5, lines 2-18). This method comprises sealing a thin diaphragm 80 and 26A over the overflow port 30 and the waste water port. (Page 7, lines 14-16 and page 6, lines 15-25).

The next step that is required by claim 1 is charging the primary drain system 34A with fluid to conduct the leakage test. (Page 8, line 30-page 9, line 6). Claim 1 also requires purging the primary drain system 34A. (Page 9, lines 7-8). The final step of claim 1 requires opening the diaphragms 80 and 26A to thereafter permit the flow of fluid through the overflow 30 and the waste water port wherein the diaphragms 26A and 80 are opened by physically cutting them open to permit fluid flow. (Page 7, line 30-page 8, line 3 and page 9, lines 7-16).

Dependent claim 5 depends on claim 1 and additionally requires wherein the waste water port is connected to the primary drain system 34A by inserting a generally L-shaped drain

pipe 16A having an upper end 20A with an annular flange 24A, a non-threaded inner end 22A, and a threaded portion 28A near the upper end 20A through a drain hole 18A of a bathtub 10 such that the annular flange 24A, covered by a flat planar membrane 26A of continuous construction that dwells in a single plane, rests on the bottom wall 26 of the bathtub 10. (Page 7, lines 10-22).

Claim 5 also requires slidably mounting a lock washer 30A over the inner end 22A of the drain pipe 16A to the threaded portion 28A and thereby tightening the lock washer against a lower surface 32A of the bottom wall 26 of the bathtub 10 and connecting the inner end 22A of the L-shaped drain pipe 16A to a drain system 34A. (Col. 7, line 23-Col. 8, line 3).

Claim 6 is also dependent on claim 1 and additionally requires wherein the waste water port is connected to the primary drain system 34A by providing a generally L-shaped drain pipe 16A having a hollow upstanding portion with an open upper end 20A and a horizontal portion with an open inner end 22A with the upstanding and horizontal portions being connected by an L-shaped portion. (Col. 7, lines 10-22). The next step of claim 6 requires placing a horizontal flange 24A around the upper end 20A of the upstanding portion and providing external threads on an outside surface of the upstanding portion. (Page 7, lines 10-29).

Claim 6 also requires inserting the open inner end 22A of the horizontal portion downwardly through a drain opening and inserting a threaded lock washer 30A with an internally threaded center bore over the inner end 22A of the horizontal portion wherein the center bore of the lock washer 30A has a diameter greater than the outside diameter of the horizontal portion, the L-shaped portion, and the upstanding portion. (Page 7, lines 23-29 and see Fig. 6). The next step of claim 6 requires sliding the lock washer 30A over the L-shaped drain pipe 16A until it

engages the external threads of the upstanding portion. (Page 7, lines 23-29). The next step is to tighten the lock washer 30A against a portion of the tub around and underneath the drain opening in the tub 10 to seal the flange 24A tightly against the tub 10 around the drain opening and connecting the open inner end 22A of the horizontal portion to the waste water drain pipe 16A. (Page 7, line 30-page 8, line 3).

Independent claim 10 also requires a method for conducting a fluid leakage test on a fluid system comprising a bathtub 20 which has a bottom 26, an adjacent side 22 and end walls 24, an overflow port 30 and an end wall 24 and with the overflow port 30 being in communication with a primary drain system. The steps of claim 10 require providing a one-piece overflow fitting 60 having an overflow pipe 62 with an inverted L-shape having an elbow portion 65 defining an upper end portion 66 and lower end portion 67. (Col. 5, lines 26-32). The upper end portion 66 having an outer end defining an inlet 71 being adapted to fit through the bathtub overflow port 30. (Page 6, lines 3-7).

The next step of claim 10 requires providing threads 68 on an outer surface of the upper end portion 66 and surrounding the inlet 71 and normally extending through the bathtub overflow port. (Page 6, lines 3-7). Additionally, the method includes providing a lip 74 extending radially outwardly from an outer surface of the overflow pipe between the elbow portion 65 and the upper end portion 66 being spaced from the inlet 71 to engage the outer surface 25 of the bathtub end wall 24 around the bathtub overflow port 30. (Page 6, lines 8-14). The next step of the method is to seal a thin diaphragm 80 to the outer end 70 of the upper end portion 66 to close the inlet 71 to fluid flow. (Page 6, lines 15-25).

The next step of method claim 10 requires opening the diaphragm 80 to permit the flow of fluid through the overflow port 30. (Page 9, lines 7-16). The next step involves threading a nut element 90 compatible with the threads 68 wherein the nut element 90 has a threaded portion for threadably mounting the nut 90 to the upper end portion 66 to clamp the overflow fitting 60 to the end of the bathtub 20 between the lip 74 and the nut element 90, and at least one lug 92 extending radially from the nut 90. (Page 6, lines 26-page 7, line 5). The final step requires detachably engaging a cap 96 to the lug 92 to cover the nut 90. (Page 7, lines 1-5).

VI. Grounds of Rejection to be Reviewed on Appeal:

Claim 10 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected to make and/or use the invention. Claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ball (U.S. Pat. No. 5,890,241) and Fritz (U.S. Pat. No. 6,192,531). Claims 5 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ball and Fritz as applied to claim 1 above and further in view of Francisco (U.S. Pat. No. 6,088,843). Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewis, Fritz and Oropallo et al. (U.S. Pat. No. 6,192,531). Claim 10 is rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claim 1 of U.S. Pat. No. 6,637,050. This rejection is not challenged in this appeal and a terminal disclaimer with respect to U.S. Pat. No. 6,637,050 has been submitted to the Patent Office to overcome this rejection.

VII. Argument:

Rejection under 35 U.S.C. § 112

Claim 10 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way it would enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For a rejection by the Examiner based on a lack of enablement requirement, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See MPEP 2164.04. Specifically, when rejecting a claim under the enablement requirement of section 112, the Examiner bears the "initial burden of setting forth a reasonable explanation as to why [he/she] believes that the scope of protection provided by [the] claim is not adequately enabled by the description of the invention provided in the specification." In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). To object to a specification on the grounds that the disclosure is not enabling with the respect to the scope of the claim sought to be patented, the Examiner must provide evidence or technical reasoning sustaining those doubts. Id.; and MPEP 2164.04. Without a reason to doubt the truth of the statements made in the patent application, the application must be considered enabling. In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). Accordingly, the case law makes clear that properly reasoned and supported statements explaining any failure to comply with section 112 are a requirement to support a rejection. In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

Specifically, the Examiner asserts that the claim recites "detachably engaging" a cap 96 to a lug 92 and a nut and that this subject matter is neither taught by the instant disclosure nor evident to the Examiner. Applicant cannot agree with the Examiner's assertion. According to the original specification on page 7, lines 1-5 the specification states that "nut element 90 has a series of radially extending lugs 92 along the nut 90 outer periphery. These lugs 92 detachably engage the inner surface of a cap 90. The cap serves to cover the overflow pipe fitting 60 hardware." Thus, the specification describes how the lugs detachably engage the inner surface of the cap 96 and the Examiner has not provided any evidence that suggests that this teaching in the specification is false nor provides evidence that this claim limitation presents subject matter that is contrary to what is well known in the art. Therefore, Applicant believes that the specification does enable one skilled in the art to make the same and respectfully requests the 35 U.S.C. § 112 rejection be reversed.

Rejection under 35 U.S.C. § 103

Claim 1 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Ball and Fritz. Applicant asserts that a combination of the prior art references would not result in the invention as claimed. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See In re Vacck, 997 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP § 2143. To establish a *prima facie* case of obviousness, all the claim limitations must be taught by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All words in a claim must be considered in judging the

patentability of that claim against the prior art." In re Wilson, 57 C.C.P.A. 1029, 1032 (1970).

Claim 1 in part requires "sealing a thin diaphragm over the overflow port and the waste water port." Ball does not teach this limitation and instead Ball teaches a conventional drain port 28 located in the bottom 26 of the bathtub 18. (Col. 2, lines 17-23). As argued by the Examiner the Ball reference also teaches that the port 28 can be plugged in any convenient manner. (Col. 2, lines 59-60). However, Ball does not teach sealing a thin diaphragm over the waste water port. Thus, Ball does not teach this limitation.

Fritz cannot cure Ball. Fritz also does not teach sealing a thin diaphragm over a waste water port. Instead, Fritz teaches a test plug 15 within a retaining body 12 that is placed through an aperture 20 of a tub wall. (Col. 3, lines 1-25). The Fritz reference does not teach sealing a thin diaphragm over a waste water port as claimed. Thus, a combination of Ball and Fritz would not result in the claimed invention.

The Examiner argues that because Ball suggests placing a plug in its drain port 28 that one skilled in the art would be motivated to use the test plug 15 of Fritz to plug the drain to arrive at the claimed invention. Applicant believes this argument is misplaced. Specifically, in the parent case, U.S. Serial No. 09/954,420 that has matured into U.S. Pat. No. 6,691,411; a reference to Fritz (U.S. Pat. No. 6,295,664) that showed a similar system of Fritz that is currently cited against the Applicant was presented. In the Notice of Allowance the Examiner stated that "Fritz et al. (6,295,664) shows a flat planar member of continuous construction 15 that is used for hydraulic testing following installation (Col. 1, lines 55-56 of Fritz) for a bathtub, however, the flat planar member does not cover the flange 12, but is instead installed within the passage

28 of the pipe." Similarly, in the present prosecution the claim requires sealing a thin diaphragm over the waste water port and not within the port as taught by the Fritz reference. Thus, even if one was motivated to combine the Ball and Fritz references the plug 15 would be within the drain and not over the waste water port as the claim requires. Thus, the combination of the prior art references would not result in the claimed invention and Applicant respectfully requests reversal of the 103 rejection.

Claims 5 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ball and Fritz as applied above and further in view of Francisco. Applicant asserts that there is no motivation to combine Francisco with Ball or Fritz. In the parent application U.S. Serial No. 09/954,420 in a final office action an Examiner rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Francisco in view of Ball with or without Fritz (U.S. Pat. No. 6,295,664) similar to the Fritz reference. In response to this rejection the Applicant provided an argument regarding the suggestion and motivation to combine these prior art references.

In light of this argument, in the Notice of Allowability the Examiner states "It is noted that Francisco teaches the flange and pipe structure claimed, however, Francisco does not specifically test for leaks using a flat planar member." Thus, Applicant reasserts that in the present prosecution that because Francisco does not test for leaks using a flat planar member as recognized in the Notice of Allowability there would be no motivation to combine the reference with Ball or Fritz to arrive at the claimed invention as asserted by the Examiner. Thus, Applicant respectfully requests that the 103 rejection be overturned.

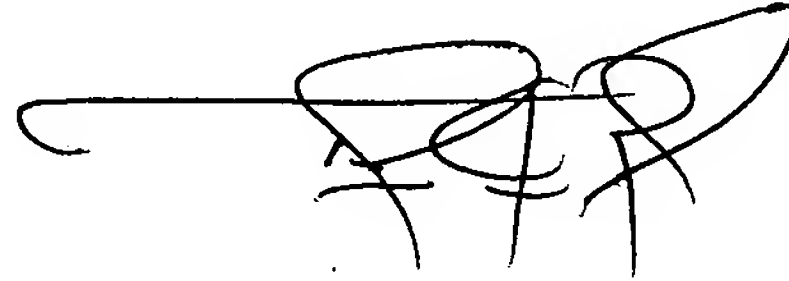
Claim 10 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lewis, Fritz and/or Oropallo. Again, Applicant asserts that a combination of these prior art references would not teach each and every limitation of the claimed invention. Specifically, the combination would not teach the step of "sealing a thin diaphragm to the outer end of the upper end portion to close the inlet to fluid flow." As discussed in the specification during installation the overflow pipe fitting 60 has an upper end portion 66 and outer end 70 wherein a diaphragm 80 is sealed to that outer end 70 as claimed. (Page 6, lines 8-25). As stated by the Examiner the overflow fitting of Lewis does not include a diaphragm. (Final office action, page 7). Similarly, Oropallo also does not contemplate the use of a diaphragm and to cure these references the Examiner uses Fritz. However, Fritz does not teach sealing a thin diaphragm to the outer end of the upper end portion of an overflow fitting as required in claim 10. Instead, Fritz teaches a plug 15 that is within retaining body 12. As best seen from Fig. 2 the retaining body 12 is a separate piece and the plug 15 fits within that element. Thus, a combination of the three prior art references would not teach a method having the step of sealing a thin diaphragm to the outer end of the upper end portion of a one-piece overflow fitting to close the inlet fluid flow as required. Thus, a combination of the prior art references would not result in the invention as claimed and Applicant asserts that the obvious rejection should be reversed.

In light of all the above arguments, Applicant believes that each pending claim provides allowable subject matter and respectfully requests reversal of all rejections.

A check in the amount of \$250 has been included with this appeal brief. All fees or extensions of time believed to be due in connection with this response are attached hereto; however,

consider this a request for any extension inadvertently omitted,
and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'TJZ', with a long horizontal line extending to the left.

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- TJZ/JLH/bjs -

Attachment: Appendix

APPENDIX

VIII. Claims Appendix

1. (previously presented) A method for conducting a fluid leakage test on a fluid system comprising a bathtub which has a bottom and adjacent side and end walls, and an overflow port in an end wall, with the bottom having a waste water port, and with the overflow port and the waste water port being in communication with a primary drain system, comprising,
sealing a thin diaphragm over the overflow port and the waste water port,
charging the primary drain system with fluid to conduct the leakage test,
purging the primary drain system from fluid,
opening the diaphragms to thereafter permit the flow of fluid through the overflow port and the waste water port;
wherein the diaphragms are opened by physically cutting them open to permit fluid flow.

2.-4. (cancelled)

5. (original) The method of claim 1 wherein the waste water port is connected to the primary drain system by inserting a generally L-shaped drain pipe having an upper end with an annular flange, a non-threaded inner end, and a threaded portion near the upper end through a drain hole of a bathtub, such that the annular flange, covered by a flat planar membrane of continuous construction that dwells in a single plane, rests on the bottom wall of the bathtub;

slidably mounting a lock washer over the inner end of the drain pipe to the threaded portion and threadably tightening the lock washer against a lower surface of the bottom wall of the bathtub, and connecting the inner end of the L-shaped drain pipe to a drain system.

6. (original) The method of claim 1 wherein the waste water port is connected to the primary drain system by providing a generally L-shaped drain pipe having a hollow upstanding portion with an open upper end and a horizontal portion with an open inner end with the upstanding and horizontal portions being connected by an L-shaped portion; placing a horizontal flange around the upper end of the upstanding portion; providing external threads on an outside surface of the upstanding portion; inserting the open inner end of the horizontal portion downwardly through a drain opening in a tub which has a diameter greater than a diameter of the upstanding portion but less than a diameter of the flange so that the flange engages a portion of the bathtub around the drain opening, inserting a threaded lock washer with an internally threaded center bore over the inner end of the horizontal portion wherein the center bore of the lock washer has a diameter greater than an outside diameter of the horizontal portion, the L-shaped portion and the upstanding portion; sliding the lock washer over the L-shaped drain pipe until it engages the external threads on the upstanding portion; tightening the lock washer against a portion of the tub around and underneath the drain opening in the tub to seal the flange tightly against the tub around the drain opening; and connecting the open inner end of the horizontal portion to the waste water drain pipe.

7. (withdrawn) An overflow fitting for a bathtub which has a bottom and adjacent side and end walls, a waste water port in the bottom and an overflow port in an end wall, comprising:

- an overflow pipe with an inverted L-shape having an elbow portion defining an upper end portion and a lower end portion, the upper end portion having an outer end defining an inlet being adapted to fit through the bathtub overflow port;
- threads on an outer surface of the upper end portion and surrounding the inlet and normally extending through the bathtub overflow port;
- a lip extending radially outwardly from an outer surface of the overflow pipe between the elbow portion and the upper end portion and being spaced from the inlet to engage an outer surface of the bathtub end wall around the bathtub overflow port; and
- a thin diaphragm sealed to the outer end of the upper end portion to close the inlet to fluid flow,
- a generally L-shaped drain pipe having a hollow upstanding portion with an open upper end and a horizontal portion with an open inner end with the upstanding and horizontal portions being connected by an L-shaped portion; placing a horizontal flange around the upper end of the upstanding portion;
- a horizontal flange around the upper end of the upstanding portion,
- external threads on an outside surface of the upstanding portion,
- the waste water port has a diameter greater than a diameter of the upstanding portion but less than a diameter of the flange so that the flange engages a portion of the bathtub around the drain opening;

the open inner end of the horizontal portion extending downwardly through the waste water port,
a threaded lock washer with an internally threaded center bore extends over the inner end of the horizontal portion wherein the center bore of the lock washer has a diameter greater than an outside diameter of the horizontal portion, the L-shaped portion and the upstanding portion;
the lock washer extending over the L-shaped drain pipe and engages the external threads on the upstanding portion and is tightened against a portion of the tub around and underneath the drain opening in the tub to seal the flange tightly against the tub around the waste water port.

8. (withdrawn) A sealing system for a bathtub which has a bottom and adjacent side and end walls, an overflow port in an end wall and a waste water port, the bottom, comprising:
an overflow pipe with an inverted L-shape having an elbow portion defining an upper end portion and a lower end portion, the upper end portion having an outer end defining an inlet being adapted to fit through the bathtub overflow port;
threads on an outer surface of the upper end portion and surrounding the inlet and normally extending through the bathtub overflow port;
a lip extending radially outwardly from an outer surface of the overflow pipe between the elbow portion and the upper end portion and being spaced from the inlet to engage an outer surface of the bathtub end wall around the bathtub overflow port;

- a thin diaphragm sealed to the outer end of the upper end portion to close the inlet to fluid flow;
- a generally L-shaped drain pipe having an upper end extending through the waste water port and having an annular flange, a non-threaded inner end, and a threaded portion near the upper end, such that the annular flange, covered by a flat planar membrane of continuous construction that dwells in a single plane, rests on the bottom wall of the bathtub;
- a lock washer over the inner end of the drain pipe on the threaded portion and threadably tightening the lock washer against a lower surface of the bottom wall of the bathtub.

9. (cancelled)

10. (previously presented) A method for conducting a fluid leakage test on a fluid system comprising a bathtub which has a bottom and adjacent side and end wall, and an overflow port in an end wall, and with the overflow port being in communication with a primary drain system steps comprising: providing a one-piece overflow fitting have an overflow pipe with an inverted L-shape having an elbow portion defining an upper end portion and a lower end portion, the upper end portion having an outer end defining an inlet being adapted to fit through the bathtub overflow port;

providing threads on an outer surface of the upper end portion and surrounding the inlet and normally extending through the bathtub overflow port;

providing a lip extending radially outwardly from an outer surface of the overflow pipe between the elbow portion

and the upper end portion and being spaced from the inlet to engage an outer surface of the bathtub end wall around the bathtub overflow port;
sealing a thin diaphragm to the outer end of the upper end portion to close the inlet to fluid flow;
opening the diaphragm to permit the flow of fluid through the overflow port;
threading a nut element compatible with the threads wherein the nut element has a threaded portion for threadably mounting the nut to the upper end portion to clamp the overflow fitting to the end of the bathtub between the lip and the nut element, and at least one lug extending radially from the nut; and
detachably engaging a cap to the lug to cover the nut.

IX. Evidence Appendix

None

X. Related Proceedings Appendix

None